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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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EXAMINER

MARSCHER, ARDIN H

ART UNIT PAPER NUMBER

1631

DATE MAILED: 06/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/057,431

Applicant(s)

MORTENSEN, PETER PAASCH

Examiner

Ardin Marschel

Art Unit

1631

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20, 28 and 44 is/are pending in the application.
- 4a) Of the above claim(s) 28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 and 44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-20, 28, & 44 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date (3 sheets).
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

VAGUENESS AND INDEFINITENESS

Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, line 6, the phrase "predicting the amount of fluorescent marker" is set forth. This is apparently the last cited step in claim 1 with the other steps being set forth as "illuminating a granular composition..." and "detecting light emitted...".. The first two steps do not seem to be connected in a clear way to the predicting step. An illumination step commonly is followed by measurement of emitted light so as to assess the amount of material via a label which responds to the illumination which presumably is the detecting step, which is then further calculated to determine a labeled material amount. Rather prediction is set forth in the last step which is reasonably interpreted as forecasting into the future. It is not clear what predicting is meant regarding an illuminated/detected composition. Clarification via clearer claim wording is requested. This unclarity is also present in claims which depend directly or indirectly from claim 1 due to their dependence.

In claims 10 and 11 prediction is described via comparison of light emitted from a composition with the light emitted from a composition with known amounts of fluorescent marker. This still is worded confusingly as such a comparison is not a forecasting as prediction implies, but rather a standardization of light signal

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compared to a known composition light signal. Clarification via clearer claim wording is requested.

PRIOR ART

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 44 is rejected under 35 U.S.C. 103(a) as being unpatentable over McNamara et al. (P/N 6,007,996).

McNamara et al. is directed to analyzing cells as summarized in the title and abstract where a stain is utilized which binds to biological targets and is reasonably biologically active thereby. Various Figures show granular cellular samples such as Figures 4A, 4B, 5A, 5B, etc. which are granular compositions as required in the instant claim. Various markers are summarized in such cell analyses in columns 1-32 including specifically fluorescent markers such as in column 5, lines 48-63, for staining DNA for measurement or detection thereof as utilized in the art. Calibration standards for use in the reference are described in column 2, lines 51-56, which suggests and motivates such standardization comparison in the art. The process of cell analysis is directed to include spectral imaging for data processing as set forth in column 25, line 15, through column 28, line 11. The description of the preferred embodiments of the reference starts in column 34, line 28, wherein imaging of simultaneous in-situ analyses is

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discussed. This imaging includes DNA staining as also discussed above and "spectral data collection device" in columns 35-37 with the device specifically cited in column 36, line 64.

Thus, it would have been obvious to someone of ordinary skill in the art at the time of the instant invention to utilize standard comparison samples in such cell (granular) analyses with image comparison to determine, that is, estimate a characteristic of a sample as described in the reference motivated and suggested as described above to result in the practice of the instant invention.

IDS

Several citations are lined through on the enclosed PTO Forms 1449 to avoid duplication of citation.

No claim is allowed.

Papers related to this application may be submitted to Technical Center 1600 by facsimile transmission. Papers should be faxed to Technical Center 1600 via the Central PTO Fax Center. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993)(See 37 CFR § 1.6(d)). The Central PTO Fax Center number is (703) 872-9306.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ardin Marschel, Ph.D., whose telephone number is (571) 272-0718. The examiner can normally be reached on Monday-Friday from 8 A.M. to 4 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, Ph.D., can be reached on (571) 272-0722.

Any inquiry of a general nature or relating to the status of this application should be directed to Legal Instrument Examiner, Tina Plunkett, whose telephone number is (571) 272-0549.

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June 24, 2004

Ardin H. Marschel 6/24/04
ARDIN H. MARSCHEL
PRIMARY EXAMINER